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10/784,898	02/24/2004	Thomas Brinkman	103864.100 US2	1032
28089	7590	06/07/2006	EXAMINER	
WILMER CUTLER PICKERING HALE AND DORR LLP 399 PARK AVENUE NEW YORK, NY 10022			MEINECKE DIAZ, SUSANNA M	
			ART UNIT	PAPER NUMBER
			3623	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/784,898

**Applicant(s)**

BRINKMAN ET AL.

**Examiner**

Susanna M. Diaz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 21-38 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-38 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

1. This Final Office action is responsive to Applicant's amendment filed May 16, 2006.

Claims 1-20 have been amended.

Claims 21-38 have been added and are presented for examination.

### ***Terminal Disclaimer***

2. The terminal disclaimer filed on May 16, 2006 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Patent No. 6,697,783 has been reviewed and is accepted. The terminal disclaimer has been recorded.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 21-38 have been considered but are moot in view of the new ground(s) of rejection, necessitated by amendment.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. Claims 21-38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tallman et al. (U.S. Patent No. 5,764,923) in view of Donnelly ("Counseling Nurses are Health Care Innovators") in view of Albaum et al. (U.S. Patent No. 5,758,095), and further in view of Moench ("Demand Management: The New Business in Patient Communications").

Tallman discloses a computer-implemented and user assisted method of providing integrated decision support to gather, maintain and update medical, demographic, psychographic, and health benefit information of members and to maintain and provide medical, and customer service information and advice using a computer system, a caller, and one or more operators, said method comprising the steps of:

[Claim 21] (a) receiving by the one or more operators a communication from the caller, the one or more operators receiving information in the communication from the caller explaining the reason for the communication including a health related issue (col. 13, lines 53-55);

(b) providing, by the computer system, the one or more operators with member profile information associated with the caller including health benefit plan information, self-reported health information, and recent contact history, and pre-existing health conditions associated with the caller (Figs. 13-16; col. 16, lines 7-50; col. 19, lines 16-58);

(c) providing, by the computer system, the one or more operators access to at least one database storing clinical information including clinical guidelines, clinical rules,

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clinical algorithms, clinical operating protocols, and clinical procedures to assist the one or more operators in identifying recommended forms of treatment, medications, and courses of action for the caller responsive to the communication (Fig. 26; col. 20, line 4 through col. 21, line 67);

(d) providing, prior to diagnosis by a physician with respect to the communication from the caller and the health related issue relating thereto, by the computer system, health benefit information including insurance company rules, member information (col. 16, lines 3-50);

(e) providing, prior to the diagnosis by the physician, by the computer system, the member profile information including the health benefit plan information, the self-reported health information, and the recent contact history, with the clinical rules, the clinical guidelines, and the clinical algorithms to assist the one or more operators in providing advice for the communication (cols. 19-28);

(f) generating, prior to the diagnosis by the physician, by the computer system, responsive to said providing steps (b), (c), (d) and (e) at least one of alerts and messages that are designed for the communication by the caller, the messages including *at least one of* appropriate prescription drug use, *medications the caller should avoid or use in moderation or speak to a physician before using, suggested forms of treatment based on the caller's symptoms*, prescription refill reminders, and prescription renewal reminders (Fig. 26);

(i) performing at least one follow up action, by the computer system, using the member profile information including *at least one of the health benefit plan information*,

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the prescription drug history, *the self-reported health information, and the recent contact history in combination with the messages including the appropriate prescription drug use, the suggested forms of treatment based on the caller's symptoms*, the prescription refill reminders, and the prescription renewal reminders (Fig. 39; col. 31, lines 42-57);

[Claim 25] determining by the one or more operators, using the computer system, while analyzing the communication from the caller, that the caller must visit a physician, requesting that the computer system generate a referral in accordance with the health benefit plan rules, and accessing a database of participating providers and rules associated with referring members to specific physicians, based on the health related issue described by the caller (Figs. 48-58);

[Claim 26] generating a report including the caller's communication, treatments or action items suggested, and referrals provided to the caller using the computer system, and notifying a health care provider associated with the caller for updating and follow up action or treatment (Figs. 48-58; col. 13, lines 42-48; col. 14, lines 23-26; col. 19, lines 16-58 – By making an appointment with a provider on behalf of a caller, the operator is notifying a health care provider associated with the caller for follow up action or treatment);

[Claim 27] updating by the one or more operators, using the computer system, while analyzing the communication from the caller, the member profile based on the communication and information given by the caller, and updating by the one or more operators the caller's self-reported health information, including existing health conditions, demographics that contribute to risk stratification, and other data applicable

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to helping the member with health care information needs (col. 13, lines 42-48; col. 14, lines 23-26; col. 19, lines 16-58);

[Claim 34] updating a member record in the member information database to include the one or more of clinical advice, pharmaceutical advice, and health benefit advice provided to the caller (col. 13, lines 42-48; col. 14, lines 23-26; col. 19, lines 16-58).

As per claims 21 and 27, Tallman does not explicitly teach the incorporation of prescription or allergy information with a caller's health history; however, Donnelly expressly teaches a nurse counseling telephone call center in which the nurses "have instant access to a caller's history of appointments, lab work, prescriptions and previous calls" (¶ 7). Further, Albaum supports the Examiner's assertion that it is old and well-known in the art of maintaining a prescription drug history to also include in the history information regarding any drug allergies (see col. 15, lines 22-27 of Albaum). Access to such prescription and allergy information is crucial when assessing a patient's present condition and prescribing additional medications; therefore, it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to adapt Tallman to incorporate a caller's prescription and allergy information with his/her records in order to facilitate more accurate patient assessments and prevent bad side effects of medications that may arise from drug contraindications, interactions, and/or allergies. Moench provides further support of the usefulness of knowing a caller's drug history, including drugs currently being used, when placing that caller in contact with a nurse at a demand management call center. Moench provides the example of Mary, a caller

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who complains of bladder leakage. After asking Mary several background questions, the nurse inquires of any medications that Mary is taking. The nurse then explains that certain medications can cause difficulties with bladder control and that it would be prudent to consult a physician for further care (i.e., the nurse explains potential side effects and complications associated with the caller's drugs). See ¶¶ 17-20. Again, Moench's scenario exemplifies the importance of knowing a caller's complete medical history, including past and current medications, in order to enhance the call center nurse's ability to dole out safe and accurate medical advice to each caller. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to incorporate with Tallman's medical advice algorithms questions regarding a caller's current medications (as taught by Moench) in order to enhance the call center nurse's ability to dole out safe and accurate medical advice to each caller.

As per claims 21 and 26, while Tallman discloses the ability to immediately connect callers with their physicians (col. 11, lines 42-61; col. 24, line 59 through col. 25, line 56), he fails to explicitly disclose that the caller's physician and the caller's health plan are provided with all details of the call, including the caller's full medical history and current medical complaints. Moench, however, expressly discloses a nurse call-center scenario in which the "nurse counselor sends an e-mail to Jake's [the patient's] pediatrician to advise him of the encounter and advice provided" (¶ 34). This step is important in allowing the pediatrician to safely and efficiently follow up on his patient's condition; therefore, the Examiner asserts that it would have been obvious to



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one of ordinary skill in the art at the time of Applicant's invention to incorporate with Tallman the step of generating, by the computer system, at least one of with respect to the health related issue reports and notices including information collected during the communication with the caller, combined with specific pharmacy information, for delivery to the physician of the caller with respect to the health related issue in order to allow the caller's physician to safely and efficiently follow up on his/her patient's condition. Further, since the health plan itself is utilizing these call centers in order to lower costs and the plan establishes the rules by which these call centers provide advice and doctor referrals (as taught by Tallman), the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to provide all information given to the caller's physician to the health plan as well in order to provide the health plan with feedback regarding the success of the call center program and with means to track the health related issues of its members for future demand management programs.

As per claim 22, Tallman does not explicitly teach the auditing of procedures and processes, random monitoring of a select number of calls, or a comparison of call reports with an overall set of performance standards; however, Official Notice is taken that such auditing and monitoring procedures are old and well-known in the art of call center management. Such auditing and monitoring procedures serve to improve call center quality by holding operators accountable for their performance as well as by constantly assessing overall call center performance in search of potential improvements to be made. Therefore, the Examiner asserts that it would have been

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obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with Tallman a method for ensuring that client-specific standards of performance are being met, including auditing of procedures and processes, random monitoring of a select number of calls, and a comparison of call reports with an overall set of performance standards in order to improve call center quality by holding operators accountable for their performance as well as by constantly assessing overall call center performance in search of potential improvements to be made.

As per claims 21 and 23, Tallman provides medical advice to callers in order to encourage more efficient use of medical services (col. 6, lines 20-40), yet he does not explicitly disclose the step of requesting by the one or more operators, using the computer system, written documents for the caller including self-care texts, brochures, newsletters, promotional materials, and other written materials which may be automatically ordered from the computer system for current and future delivery to the caller, the caller's health care plan, a physician, and optionally a pharmacist. However, Official Notice is taken that it is old and well-known in the art of health care for a health plan to target its members with educational, medical materials. The health plans implement such demand management programs, e.g., in which they target educational information regarding health issues most likely to affect each member, in an attempt to lower health costs by promoting illness prevention through this educational information. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to implement with Tallman the step of requesting by the one or more operators, using the computer system, written

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documents for the caller including self-care texts, brochures, newsletters, promotional materials, and other written materials which may be automatically ordered from the computer system for current and future delivery to the caller, the caller's health care plan, a physician, and optionally a pharmacist, (i.e., targeting the caller for new action based on the caller's full medical history and health benefit information) in order to proactively implement a demand management program in an attempt to lower health costs by promoting illness prevention through this educational information.

As per claims 21 and 24, while Tallman does not explicitly teach the ability of its operators to request a new prescription, a prescription refill, or a prescription renewal for direct delivery to or pick up by the caller, Official Notice is taken that it is old and well-known in the art to have prescriptions called in by a physician's representative on a patient's behalf. This relieves the physician of minor duties so that he/she can spend more time with patients. Further, Official Notice is taken that it is old and well-known in the art of health care for a physician to prescribe medication covered by a patient's health care plan. This reduces out-of-pocket costs incurred by a patient. Therefore, the Examiner asserts that it would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to enable Tallman's operators to request a new prescription, a prescription refill, or a prescription renewal (determined to be covered by the caller's health care plan) for direct delivery to or pick up by the caller in order to quickly and conveniently provide the caller with a prescription preapproved by his/her physician while freeing up the physician's time so that he/she can spend more time with patients and save the patient extra out-of-pocket costs.

[Claims 28-33, 35] Claims 28-33 and 35 recite limitations already addressed by the rejection of claims 22-27 above; therefore, the same rejection applies.

[Claims 36-38] Claims 36-38 recite limitations already addressed by the rejection of claims 21-27 above; therefore, the same rejection applies.

### ***Conclusion***

6. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Susanna M. Diaz whose telephone number is (571) 272-6733. The examiner can normally be reached on Monday-Friday, 10 am - 6 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272-6729. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Susanna M. Diaz  
Primary Examiner  
Art Unit 3623

May 25, 2006